

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in view of the above amendments and following remarks, is respectfully requested.

Claims 13-16 remain active in this application. By this amendment, Claim 14 has been amended. As the amendment to Claim 14 is directed to formal matters, it is respectfully submitted that no new matter has been entered.

In the outstanding Final Office Action, Claim 14 was objected to as informal; Claims 14 and 16 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; Claims 13-15 were rejected under 35 U.S.C. § 102(e) as being anticipated by Knudson et al. (US 2006/0095937 A1, hereinafter “Knudson”); and Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Knudson in view of Patel et al. (US 2004/0078829 A1, hereinafter “Patel”).

The rejection of Claims 14 and 16 under 35 U.S.C. § 112, first paragraph, as reiterated in the Advisory Action, as failing to comply with the written description requirement, is respectfully traversed. The Office Action asserts “[t]he specification provides no support for receiving the file **from** a recording and playback apparatus.” Applicants respectfully disagree.

The paragraph bridging pages 30 and 31 the specification states:

When it is determined that the search mode based on characteristic words is selected, the process proceeds to step S42. The recording/reproducing apparatus 3 issues an instruction to the server 2 connected to the network 1 so as to supply the characteristic word file 103.

Furthermore, in the specification paragraph bridging pages 31 and 32 and in the following paragraph the specification states:

The audience can move the cursor 131 to an intended word by operating the arrow key 74 of the remote controller 71.

When the cursor 131 is positioned to an intended word, the audience can select that word to be used for the television program search.

Thus, it is clear that the characteristic word file includes a list of characteristic words as shown, for example, in application FIGS. 14 and 15 from which the audience can select an intended characteristic word. Furthermore, Claim 13, lines 4 to 5 make clear that there is included in the claimed combination “an input device configured to allow a user to select an intended characteristic word from characteristic words contained in said file. (Emphasis added).” As shown in FIG. 13 box S42 “ISSUE INSTRUCTION TO SUPPLY CHARACTERISTIC WORD FILE” is shown providing an output to SERVER 2. That is, the progression of arrows in FIG. 13 shows the arrows coming from the RECORDING/REPRODUCING APPARATUS 3 to S41 SET TO SEARCH MODE? to S42 ISSUE INSTRUCTION TO SUPPLY CHARACTERISTIC WORD FILE to SERVER 2. Thus, the specification provides support for the amended recitation in Claim 14 “wherein said first device receives a file containing information about characteristic words including said characteristic word from said recording and playback apparatus.” Similarly, the specification provides support for the similar recitation of Claim 16. Therefore, it is respectfully requested that the rejection of Claims 14 and 16 under 35 U.S.C. § 112, first paragraph, be reconsidered and withdrawn.

Claim 13 recites:

a device configured to transmit information about a characteristic word selected by said user to a recording and playback apparatus; and

a second device configured to receive television program information about a television program corresponding to said selected characteristic word transmitted from said recording and playback apparatus as a result of transmitting information about said selected characteristic word.

Independent Claims 15 and 16 recite similar subject matter. It is respectfully submitted that these features are neither disclosed by nor rendered obvious by Knudson.

The Office Action asserts that Knudson teaches:

A device (server) configured to transmit information about a characteristic word selected by said user to a recording and playback apparatus (a server with a database 24 performs a search of program guide information and transmits the search results back to the user equipment [0062]; user equipment may be a recording and playback apparatus [0040]); and

A second device (television) configured to receive television program information about a television program corresponding to said selected characteristic word transmitted from said recording and playback apparatus as a result of transmitting information about said selected characteristic word (a television 40 [Fig 1] displays the search results for the user [0063]).

The Office Action makes similar assertions with regard to Claims 15 and 16. Applicants respectfully disagree.

Knudson states in paragraph [0062] “[t]he search may be performed in database 36 or 45 by the user equipment 26 or 28, or alternatively in database 24 at television distribution facility 20 when a client-server architecture is used (FIG. 1).” Knudson further shows in FIG. 2 that after program listings are searched for programming matching a selected category in box 76 that the display displays the search result in box 78. That is, Knudson fails to describe a device configured to transmit information about a characteristic word selected by said user to a recording and playback apparatus. Further, Knudson fails to describe a second device configured to receive television program information about a television program corresponding to said selected characteristic word transmitted from said recording and playback apparatus as a result of transmitting information about said selected characteristic word. Therefore, Knudson fails to describe the features of Claim 13 quoted above and the similar recitations recited in Claims 15 and 16.

Furthermore, the Office Action fails to clearly point out where the above quoted features are asserted to be described in Knudson. For example, Knudson paragraph [0063] states “[a]t step 78, the program guide displays the results of the search, i.e., the program listings that match the selected category.” There is no description in this paragraph or elsewhere of “a second device (television) configured to receive television program information about a television program corresponding to said selected characteristic word **transmitted from said recording and playback apparatus as a result of transmitting information about said selected characteristic word** [emphasis added]” as asserted in the Office Action.

Patel fails to correct the deficiencies of Knudson pointed out above. Patel states “the second programming content is recorded during the broadcast thereof at a location (e.g., a headend of a cable TV system) remote from the set-top terminal.”<sup>1</sup> There is no teaching, suggestion, motivation or other logical reason provided by Patel for controlling transmission of information about a characteristic word selected by said user to a recording and playback apparatus as recited in Claim 16. Therefore, Patel does not provide a *prima facie* case of obviousness as asserted in the Office Action with regard to Claim 16.

Furthermore, language identical to that recited in Claim 16 is also recited in Claim 15, and Patel has not been applied in a rejection of Claim 15. That is, Claims 15 and 16 differ only in the preambles thereof. Therefore, the inconsistency in the Office Action in the rejections of Claims 15 and 16 is not understood. Further clarification is respectfully requested.

Therefore, the statement in the Office Action “Knudson does not teach that the headend server to which information about a characteristic word is transmitted is a recording and playback apparatus” appears to be an admission that Knudson does not anticipate Claims

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<sup>1</sup> Paragraph [0015].

13-15 as alleged previously in the Office Action. Additional clarification is requested with regard to this apparent inconsistency as well.

It is respectfully submitted that Claim 14 is patentable at least for the reasons argued above with regard to Claim 13 from which it depends.

Accordingly, it is respectfully requested that the rejections of Claims 13-16 be reconsidered and withdrawn, and that Claims 13-16 be found allowable.

Consequently, for the reasons discussed in detail above no further issues are believed to be outstanding in the present application and the present application is believed to be in condition for formal allowance. Therefore, a Notice of Allowance is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact the undersigned representative at the below-listed telephone number.

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